Inventor(s): J. T. Lin Appln. No.: 0 / or Patent No. Filed: May 27, 1998 or Issued: Title: OPHTHALMIC SURGERY METHOD USING NON-CONTACT SCANNING LASER					
VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY STATUS (37 CFR 1.9(d) and 1.27(c)) - SMALL BUSINESS CONCERN  I hereby declare that I am  [ ] the owner of the small business concern identified below: [X] an official of the small business concern empowered to act on behalf of the concern identified below:  NAME OF CONCERN LaserSight, Incorporated  ADDRESS OF CONCERN 12249 Science Drive, Suite 160  Orlando, Florida 32826					
I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.12, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees under Section 41(a) and (b) of Title 35, United States Code, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.  I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern					
identified above with regard to the invention entitled:  OPHTHALMIC SURGERY METHOD USING NON-CONTACT SCANNING LASER					
by inventors(s) J. T. Lin described in  X					
status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))					
I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.					
NAME OF PERSON SIGNING William I. Kern					
TITLE OF PERSON OTHER THAN OWNER Vice President of Corporate Development					
ADDRESS OF PERSON SIGNING 159 Durham Place, Longwood, Florida 32779					
SIGNATURE DATE 5/4/98					

# DECLARATION AND POWER OF ATTORNEY FOR REISSUE APPLICATION BY ASSIGNEE AND INVENTOR

We, Dr. J. T. Lin and William I. Kern in support of the reissue declaration of inventor and assignee, declare and state as follows:

- 1. We believe that Dr. J. T. Lin is the original, first and sole inventor of the invention entitled OPHTHALMIC SURGERY METHOD USING NON-CONTACT SCANNING LASER described and claimed in Letters Patent No. 5,520,679 issued on May 28, 1996 from original Application No. 08/218,319 filed March 25, 1994, which is a Continuation-in-Part of Application No. 07/985,617, filed December 3, 1992, and described and claimed in the foregoing attached reissue application. We do not believe that this invention was known or used in the United States before Dr. J. T. Lin's invention thereof, or patented or described in any publication in any country before his invention thereof or more than one year prior to the original application dates of December 3, 1992 or March 25, 1994, or in public use or on sale in the United States more than one year prior to the original application dates of December 3, 1992 or March 25, 1994. This invention has not been patented in any country foreign to the United States prior to the date of the original application on an application filed by Dr. J. T. Lin or his legal representatives or assigns more than 12 months before his original application. We have reviewed and understand the contents of specification and claims as amended by the attached reissue application.
- 2. Dr. J. T. Lin's residence, post office address and citizenship are as stated below next to his signature.





## Certificate Under 37 C.F.R. § 3.73(b)

- 3. LaserSight, Incorporated certifies that it is the assignee of the entire right, title, and interest in U.S. Patent No. 5,520,679 by virtue of the assignment from Dr. J. T. Lin of Application Serial No. 08/218,319, filed March 25, 1994, recorded on reel 6939 at frame 975. A copy of the assignment is attached herewith.
- 4. William I. Kern is the Vice President of Corporate Development of LaserSight, Incorporated and he is authorized to act on behalf of assignee. William I. Kern's residence, post office address, and citizenship are as stated below next to his signature.

## **Consent of Assignee**

5. The assignee consents to the accompanying application for reissue.

# Reason for Requesting Reissue

6. We now understand and believe that certain language is unnecessarily limiting and its inclusion in the claims of U.S. Patent No. 5,520,679 is an error introduced by prior counsel, who apparently failed to appreciate the significance of the invention. Thus, we believe the original U.S. Patent No. 5,520,679 contains an error that occurred without deceptive intent that renders the patent partly inoperative as a legal document by reason of the patentee claiming less than he had a right to claim.

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## **Summary of Prosecution File History**

7. For the Examiner to fully understand the circumstances which gave rise to the decision to file this reissue application, the invention and the prosecution history of Application No. 08/218,319 are summarized.

Patent Application Serial No. 08/218,319 was filed on March 25, 1994, claiming priority from parent Application Serial No. 07/985,617, filed December 3, 1992. Application Serial No. 08/218,319 included claims directed to a method of performing corneal refractive surgery by reshaping a portion of the corneal surface using a laser. Original claim 1 recited:

selecting a laser having a pulsed output beam of predetermined ultraviolet wavelength and having an energy level less than 10 mJ/pulse;

selecting a scanning mechanism for scanning said selected laser output beam;

coupling said laser beam to a scanning device for scanning said laser beam over a predetermined surface area;

focusing said scanning laser beam onto the corneal surface of a patient's eye to a predetermined spot size;

aligning the center of the said scanning laser beam onto the patient's eye corneal surface with a visible aiming beam; and

controlling the scanning mechanism to deliver the scanning laser beam in a predetermined overlapping pattern onto a plurality of positions on the corneal surface to photoablate or photocoagulate the corneal tissue whereby a patient's vision is corrected by reshaping of the corneal surface of the patient's eye.

In a first Official Action, dated April 4, 1995, the Examiner rejected claims 1-25 for informal reasons, claims 1, 12-19, 24 and 25 as allegedly being anticipated by U.S. Patent No. 4,729,372 (L'Esperance) under 35 U.S.C. § 102(b) and claims 3-13 and 20-23 as allegedly being obvious over L'Esperance under 35 U.S.C. § 103. In particular,

the Examiner alleged that L'Esperance "discloses a method and apparatus for performing laser surgery on the eye as claimed, including the steps of coupling the laser to a scanning device 14 to deliver a scanned beam to the corneal surface." The Examiner admitted that L'Esperance does not disclose "the particular parameters recited" in the claims, but alleged that to provide L'Esperance "with the particular irradiation ranges and parameters recited would have been obvious to an artisan of ordinary skill in the art for facilitating the corrective therapeutic outcomes."

An Amendment responsive to the first Official Action was filed on August 4, 1995. Claims 1, 2, 5-12, 14-19 and 25 were amended to address informalities. Claim 1 was also amended to recite the removal of from .05 to .5 microns of corneal tissue per pulse. The Applicant argued that L'Esperance did not teach using an irradiation energy level of 10 mJ/pulse or less or removal of from 0.5 to .5 microns of corneal tissue per pulse as recited. The Applicant pointed out that L'Esperance proliferated the use of conventional high power laser beam equipment by teaching the removal of 14 microns of tissue per pulse, i.e., 42 times the maximum amount recited in claim 1 of the application.

In a second Official Action dated November 21, 1995, the Examiner rejected claims 1 and 5-25 under 35 U.S.C. § 103 as allegedly being obvious over L'Esperance. Claims 2-4 were deemed to include informal errors but nevertheless to recite allowable subject matter. The Examiner correctly understood that the invention was "directed towards reducing the size and power of the laser for performing this surgery." The Examiner admitted that L'Esperance disclosed laser power far outside of the claimed range, i.e., having a maximum power of 200 mJ/pulse in a disclosed embodiment which removes 14 microns of tissue per pulse.

An Amendment responsive to the second Official Action was filed on December 22, 1995. Claim 1 was amended to incorporate the subject matter of allowable claim 2, claims 3 and 4 were amended to be dependent upon claim 1, and claim 25 was canceled. The Amendment was entered and the Examiner issued a Notice of

Allowability on January 31, 1996, and U.S. Patent No. 5,520,679 issued on May 28, 1996.

#### **How the Error Was Discovered**

8. Through consultation with counsel, the Assignee became aware that the presence of language relating to a visible aiming beam in claim 1 was not required to distinguish from the prior art, nor was the feature ever discussed in the file history.

## **The Error Was Made Without Deceptive Intent**

9. All errors being corrected by the request for re-issue of Patent No. 5,520,679 were made without deceptive intent.

#### **How the Error is Corrected**

10. To correct the error, new claims 24 through 98 have been added which do not require a "visible aiming beam." The Applicant had a right to claim the invention without requiring a "visible aiming beam," as is clear from a review of the prosecution history and cited art.

For instance, in the Notice of Allowability dated January 31, 1996, the Examiner stated the following reasons for allowance:

"... the claims now set forth a specific method for performing corneal refractive surgery which includes the steps of selecting a particular laser source and scanning mechanism, and controlling the scanning mechanism to remove a specific amount of corneal tissue through the use of a low power laser. The prior art fails to anticipate or fairly suggest the method steps as set forth in the claims."



We now understand and believe that the language relating a visible aiming beam is unnecessarily limiting and its inclusion in the claims is an error introduced by our prior counsel, who apparently failed to appreciate the significance of the invention. The "visible aiming beam" feature was not argued or even referred to by the Applicant or by the examiner during prosecution of the subject '679 patent. Thus, the new claims presented herewith which do not recite a visible aiming beam should be allowed over the prior art of record for the same reasons the Examiner allowed the claims of the subject '679 patent.

## **Support for New Claims**

11. No new matter has been added by new claims 24 through 104. Support for each of the following new claims can be found in the parent Application Serial No. 07/985,617, filed on December 3, 1992, inter alia as follows:

New claim 24 at page 6, line 19, page 10, line 20, and page 19, line 25;

New claims 25, 49, 79, 84 and 95 at page 6, lines 12-13;

New claims 26, 50 and 96 at page 15, line 7;

New claim 27 at page 19, line 14;

New claims 28-31, 40 and 57-59 at page 13, line 10 and page 19, line 16;

New claims 32, 41, 60, 72 and 97 at page 13, line 9;

New claims 33, 34, 43, 62, 70 and 93 at page 10, line 15;

New claims 35, 44 and 63 at page 15, lines 22-23;

New claims 37, 46 and 65 at page 23, lines 1-2;

New claims 38, 47, 66 and 89 at page 23, line 17;

New claims 39 and 76 at page 13, lines 9-13, and page 15, line 7;

New claims 42, 61 and 92 at page 19, line 25;

New claim 48 at page 6, line 11, page 14, lines 8-10, page 15, line 22 through page 16, line 7, page 23, lines 21-29, and Figs. 6A-6D;

New claim 51 at page 22, line 9;

New claim 52 at page 6, line 14;

New claim 53, 54, 73 and 74 at page 6, line 11;

New claim 55 at page 4, line 29;

New claim 56 at page 19, line 14;

New claims 67 and 68 at page 23, lines 1-20, and Fig. 6B;

New claim 69 at page 15, line 22 to page 16, line 7, page 23, lines 21-29, and Figs. 6A through 6D.

New claim 75 at page 6, line 13;

New claim 80 at page 15, lines 22-33;

New claims 81 and 87 at page 14, lines 8-10;

New claims 82, 83 and 98 at page 13, lines 5-9, and 15, line 7;

New claim 85 at page 6, line 21;

New claim 86 at page 4, line 28;

New claims 91 and 99 at page 6, line 18 to page 7, line 12;

New claims 102 and 103 at page 18, lines 10-11; and

New claim 104 at page 19, line 22.

Support for each of the following new claims can be found in Application Serial No. 08/218,319, filed on March 25, 1994, inter alia as follows:

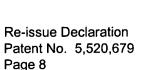
New claims 36, 45, 64, 78 and 94 at page 15, line 7, page 27, line 26 in combination with page 29, line 16;

New claim 77 at page 32, line 5; and

New claims 100 and 101 at pages 9 and 10.

Support for new claim 90 can be found at patent claim 1.





## **Acknowledgment of Duty of Disclosure**

12. We acknowledge the duty to disclose to the United Stated Patent and Trademark Office information which is material to the examination of this reissue application in accordance with 37 C.F.R. §1.56(a).

#### Offer to Surrender Patent

13. We request that we may be allowed to surrender, and hereby offer to surrender our said U.S. Letters Patent No. 5,520,679 before allowance of the reissue application, and that Letters Patent may be issued for the same invention upon the foregoing amended specification and claims.

# **Power of Attorney and Correspondence Address**

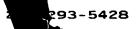
14. We hereby appoint the registered patent attorney's represented by **Customer No. 20736** to prosecute this reissue application and transact all business in the U.S. Patent and Trademark Office connected herewith. Please direct all correspondence to:

William H. Bollman Farkas & Manelli, PLLC 2000 M Street, N.W., 7<sup>th</sup> Floor Washington, D.C. 20036-3307 Tel: (202) 261-1000

Fax:(202) 861-0336

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15. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this reissue application or any patent issued thereon.

Inventor's Signatur	e: 🖯	H:		Date: May 21, 1998	
Inventor's Name:	J.	Т.	Lin	U.S.A.	
	First	Middle Initial	Family Name	Country of Citizenship	
Residence (City): Winter Springs			(State/Foreign Country) Florida		
Post Office Address (Include Zip Code): 730 Willow Run lane, Winter Springs,					
Florida 32792					
Assignee:LaserSight Incorporated					
Signature:			**************************************	Date: 5/21/98	
By: William	,	<u> </u>	Kern	U.S.A.	
First	M	iddle Initial	Family Name	Country of Citizenship	
Assignee's Title: Vice President of Corporate Development, LaserSight, Incorporated					
Residence (City):_	Longw	ood	(State/Foreig	n Country) Florida	
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